

### **REMARKS**

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 1, 3-8, 10, 11, 13, 14 and 16-20, as well as newly presented Claims 38-40, the only claims pending and under examination in this application following entry of the above amendment.

The Examiner is thanked for withdrawing the rejections under 35 U.S.C. §§ 112, second paragraph; and 102(b) or 103(a) over Spengler (Pat. No. 6,669,879).

The Applicant concedes that, in the previous response filed May 8, 2008, Claim 3 inadvertently included an incorrect status indicator. Claim 3 was not amended in the previous response.

### ***Formal Matters***

Claim 1 has been amended to limit the synthetic pesticide to a phytotoxicity-inducing synthetic pesticide. Support for the amendment can be found in ¶ 0017 spanning pages 5-6 and ¶ 0019 spanning pages 6-7 of the Specification. Claim 1 has been further amended to specify that the composition reduces pesticide-induced phytotoxicity of a plant. Support for this amendment can be found throughout the specification of the present application, e.g., on page 3, ¶ 0007 and page 5, ¶ 0016, as well as originally filed Claim 31.

New Claim 38 finds support in ¶ 0002 on page 2, the Examples IIA to IID on pages 35-41, Table 1 spanning pages 7-8 of the Specification. New Claim 39 finds support on page 6, ¶ 0018 of the Specification. New Claim 40 finds support on page 5, ¶ 0016.

As no new matter is introduced, entry of the amendments by the Examiner is respectfully requested.

***Claim Rejection under 35 U.S.C. §103***

Claims 1, 3-8, 10, 11, 13, 14 and 16-20 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Summers (3,514,516) in view of Beaty (5,634,959) and Parker (2007/0134284). This rejection is respectfully traversed.

In making this rejection, the Office asserts that the combination of Summers' nematodcide & fertilizer, Beaty's advantageous fertilizer forms and Parker's teaching of EDTA as an insecticidal pesticide renders the claimed invention obvious. Office Action, page 3, ¶ 1.

In order to meet its burden in establishing a rejection under 35 U.S.C. §103, the Office must first demonstrate that a prior art reference, or references when combined, teach or suggest all claim elements. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007); *Pharmastem Therapeutics v. Viacell et al.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007); MPEP § 2143(A)(1). Furthermore, "Courts determining whether claimed combination of elements known in prior art would have been obvious will often be required to look to interrelated teachings of multiple patents, effects of demands known to design community or present in marketplace, and background knowledge of person of ordinary skill in art in order to determine whether there was apparent reason to combine known elements in manner claimed in patent in suit, and in order to facilitate review, this analysis should be made explicit....." *KSR* at 1739. As such, in addition to demonstrating that all elements were known in the prior art, there must be some apparent reason to combine the elements of the art in the manner stated in the claims at issue.

Applicant submits that the claimed invention is not obvious over Summers in view of Beaty and Parker because 1) the combination of the cited references fails to teach a phytotoxicity-inducing synthetic pesticide; and 2) there is no apparent reason for combining the claimed elements as asserted by the Office.

The claimed invention is directed to a pesticide composition comprising *inter alia* a phytotoxicity-inducing synthetic pesticide. The composition reduces pesticide-induced phytotoxicity of a plant.

Pursuant to the Specification, “Many pesticides (insecticides, bactericides and fungicides) used in agriculture impart phytotoxic responses, i.e., subtle to distinct hindrances to the physiological functions of various plant species” (page 1, ¶ 0002).

The Inventor of the present Application discovered the unexpected result that the claimed composition at least reduces pesticide-induced phytotoxicity (Specification, page 6, ¶ 0018). In certain instances, the phytotoxic effects are completely eliminated (*Id.*). The Example Section evidences that the embodiments of the claimed composition mitigated insecticide-induced phytotoxicity of tomato plants (see Example IIA); bactericide-fungicide-induced phytotoxicity of mung bean plants (see Example IIB); fungicide-induced phytotoxicity of tomato plants (see Examples IIC and IID). In particular, Example IIA shows that an exemplary composition not only led to nearly 175% improvement in growth in tomato plants as compared to treatment with only the pesticide; but also exhibited no phytotoxic effects at all as compared to treatment with only a fertilizer (page 36, result table).

Summers does not teach or suggest a composition including a phytotoxicity-inducing synthetic pesticide. Summers’ nematocide is applied to the soil only – i.e., “the complete field (broadcast), a strip of pre-determined width centered on the crop row (band), a spot at each individual plant or hill of plants, or the immediate area of the planting furrow (in-the-row)” (col. 9, lines 14-21). As such, the nematocide is present in the soil and would not induce phytotoxicity of a plant. Furthermore, because Summers’ nematocide is used to control soil inhabiting plant-parasitic nematodes (col. 9, lines 14-15 and lines 31-32), it is not even suggested that the nematocide would be applied to the plant.

Furthermore, in Summers, the plants grown in nematocide-treated soil showed no hindrances to the physiological functions – i.e., phytotoxicity. Rather, the plants grown in treated plots made a rapid growth and produced a good yield in comparison with the plants grown in untreated plots (Examples 21-30 in cols. 12-15). This indicates that the nematocide did not induce phytotoxicity of the plants. Therefore, Summers fails to teach or suggest a phytotoxicity-inducing synthetic pesticide as claimed.

Beaty teaches a fertilizer mixture including EDTA, which is allegedly a synthetic pesticide. Nowhere does Beaty indicate that EDTA is a pesticide.

Indeed, the knowledge that EDTA is a pesticide comes from Parker, as the Examiner acknowledges in the Office Action. Parker teaches that EDTA is an environmentally safe, non-toxic pesticide (¶¶ 0007 and 0028). As such, Parker's EDTA would not induce phytotoxicity of plants.

Therefore, Beaty and Parker fail to teach or suggest a phytotoxicity-inducing synthetic pesticide as claimed.

Accordingly, the combination of Summers, Beaty and Parker does not teach or suggest all of the claim limitations and therefore fails to render the instant claims obvious. Accordingly, this rejection may be withdrawn for this reason alone.

Furthermore, Applicant submits that there is no apparent reason for one of skill in the art to combine the references.

In articulating a reason to combine the elements, the Examiner asserts that one of ordinary skill in the art would have combined Summers' nematocide with the advantageous fertilizer forms of Beaty to save time, energy and cost of applying separate compositions (Office Action, page 3, first ¶).

However, Summers teaches that its nematocide is used to control soil inhabiting plant-parasitic nematodes and thus applied to the soil (col. 9, lines 14-21). On the other hand, Beaty teaches that its fertilizers are directly applied to the plants (col. 4, lines 20-21). Upon reading the two references, one of ordinary skill in the art would not be able to combine Summers' nematodes with Beaty's fertilizer composition to produce one composition because one is applied to the soil and the other is applied to the plant.

Accordingly, Summers and Beaty cannot be combined because there is no apparent reason to combine the elements allegedly taught in the references. Accordingly, this rejection may be withdrawn.

Finally, newly presented Claims 38-40 are patentable over Summers in view of Beaty and Parker for at least the reasons provided above.

**CONCLUSION**

The Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number YAMA-009.

Respectfully submitted,  
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